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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/675,978

09/30/2003

Don Post

PMG-05-1321

6281

35811

7590

10/17/2006

IP GROUP OF DLA PIPER US LLP  
ONE LIBERTY PLACE  
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PHILADELPHIA, PA 19103

EXAMINER

CHOI, JACOB Y

ART UNIT

PAPER NUMBER

2875

DATE MAILED: 10/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/675,978	POST ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jacob Y. Choi	2875	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Specification*

1. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### *Claim Objections*

2. Claims **1, 6, 13 & 16** are objected to because of the following informalities: It has been held that the recitation that an element is "*adapted to*" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. Appropriate correction is required.

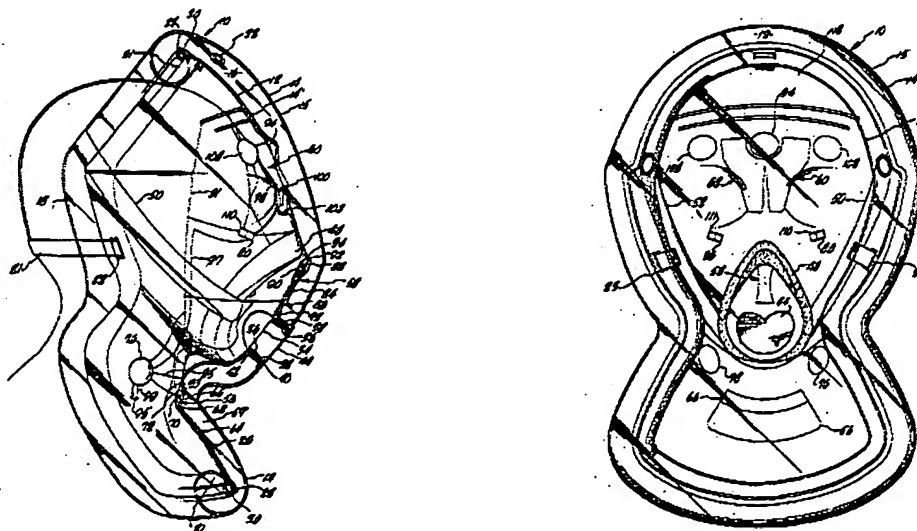
### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

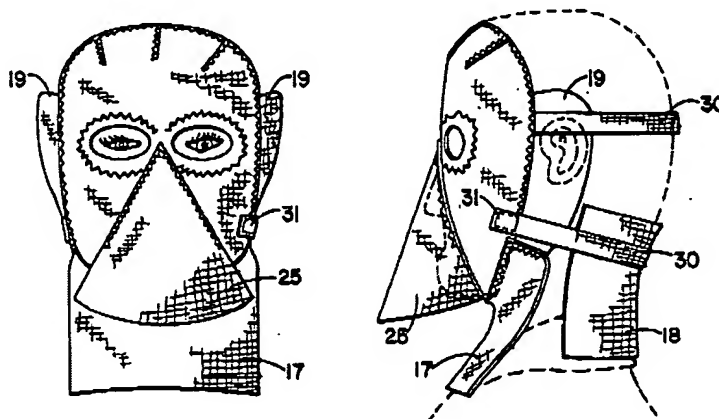
4. Claims **1-18** are rejected under 35 U.S.C. 103(a) as being unpatentable over Baron (USPN 4,233,689) in view of Pulju (USPN 3,878,563).

Regarding claims **1, 6, 10, 13 & 16-18**, Baron discloses a first masking layer (e.g., 12), the first layer having a transparent sheets (e.g., 14 & 14') without impairing vision (e.g., column 1, lines 60-65; "*... another object of the present invention to provide protective headgear for protecting the wearer's head and face without impairing his vision ... etc.*" & column 4, lines 50-55; "*... the interior shell below the wearer's eyes where it is clearly visible ... etc.*"), a second masking layer (e.g., 14 or 14') positioned over the first masking layer and secured thereto in a spaced relationship (e.g., 16), the second masking layer having a transparent sheet(s) (e.g., 14 or 14') without impairing vision, which are in substantial registration with the first layer, a plurality of lamps (e.g., LEDs; 80) fixedly positioned between the first (e.g., 12) and second (e.g., 14 & 14') masking layers and, a controller (e.g., circuit/switches; columns 4-5, lines 60-10) for controlling the activation of the plurality of lamps (e.g., LEDs) in a desired pattern, the activation of the lamps being visible, a translucent material (e.g., column 2, line 40), through the second masking layer which is positioned over the lamps (e.g., Figure 2).



Baron failed to disclose the openings for the eyes of the wearer in both first and second masking layer & failed to disclose a screen material positioned over the eye openings. However, Baron clearly suggest that in column 1, lines 60-65; "... *another object of the present invention to provide protective headgear for protecting the wearer's head and face without impairing his vision ... etc.*".

Pulju teaches the openings (20; e.g., Figure 3) for the eyes of the wearer in both first (e.g., 12) and second (e.g., 11) masking layer.



Modification step one - it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the openings for the eyes on the mask of Baron, providing an alternative solution to increase the visibility of the mask wearer. Prior art reference Baron suggest that the protective headgear requires to protect the wearer's head and face without impairing his vision (e.g., column 1, lines 60-65) and providing an openings for the eyes on the mask, teachings of Pulju, would further enhance the wearer's vision. In addition, the following modification (the openings for the eyes) is possible, since the prior art reference Baron has an aperture (e.g., 34)

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provided in the shell opposite the location of the wearer's mouth (e.g., column 3, lines 20-55) on a pair of transparent inflatable shock absorbing air chamber.

Modification step two - Further more, the prior art reference Baron suggest of using a screen (e.g., 44) to enhance the wearer's protection and it would have been obvious to one of ordinary skill in the art at the time of the invention to additionally provide the openings for the eyes with the screen to protect the wearer's eyes. It has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Modification step three - also, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify masking layer of Baron to other transparent/translucent material so that it hides the lamp structures yet permits the light from the lamps to be visible to enhance the ecstatic appearance of the mask. The following modification would have permitted a pleasing/decorative effect. It has been held to be within the general skill of a worker in the art to select a known material on a basis of its suitability for the intended use as a matter of obvious design variation. *In re Leshin*, 125 USPQ 416.

**Note:** Claims in pending application should be given their broadest reasonable interpretation. *In re Pearson*, 181 USPQ 641 (CCPA 1974).

The term transparent and translucent is defined as **a - capable of transmitting light** so that objects or images can be seen as if there were no intervening material. **b - transmitting light** but causing sufficient diffusion to prevent perception of distinct images, **clear**. Claims in a pending application should be given their broadest reasonable interpretation. *In re Pearson*, 181 USPQ 641 (CCPA 1974).

Things clearly shown in reference patent drawing qualify as prior art features, even though unexplained by the specification. *In re Mraz*, 173 USPQ 25 (CCPA 1972).

It has been held that the recitation that an element is "*adapted to*" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Regarding claim 3, Baron in view of Pulju discloses the claimed invention, explained above. In addition, Pulju discloses the first masking layer comprises an opaque material (e.g., column 2, lines 38-39; "*durable plastic material*").

**Note:** It has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design variation. *In re Leshin*, 125 USPQ 416.

Regarding claims 4, 11, Baron in view of Pulju discloses the claimed invention, explained above. In addition, Baron discloses a plurality of spacer (e.g., 31) elements secured to the inside of the first masking layer for positioning the first masking layer in a space relationship with respect to the wearer's face when the device is worn.

Regarding claims 5, 12, Baron in view of Pulju discloses the claimed invention, explained above. In addition, Baron discloses a hood (e.g., 26) which is secured to the peripheral edges of the second masking layer and which covers the rear of the wearer's head when the device is covering the wearer's face and eyes.

Regarding claim 7, Baron in view of Pulju discloses the claimed invention, explained above. In addition, Baron discloses the controller further comprises a power source in the form of batteries (e.g., 82).

Regarding claims 8, 14, Baron in view of Pulju discloses the claimed invention, explained above. In addition, Baron discloses the controller causes a flashing pattern by the plurality of lamps upon their activation (e.g., columns 5-6, lines 60-5).

Regarding claims 9, 15, Baron in view of Pulju discloses the claimed invention, explained above. In addition, Baron discloses a switch (e.g., 60, 62) for causing activation of the plurality of lamps.

***Response to Amendment***

5. Examiner acknowledges that the application has amended claims 1, 4, 6, 10, 13 and 16 and newly added claims 17 & 18. Currently, claims 1-18 are pending in the application.

***Response to Arguments***

6. Applicant's arguments filed July 24, 2006 have been fully considered but they are not persuasive.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that the references fail to show certain features of applicant's invention, the features upon which applicant relies (i.e., "... *only the lower portion of the Pulju mask has multiple layers ... etc.*"), it is noted that Baron, the primary reference, disclose the every element that is recited in the claim(s) but only failed to disclose the openings for the eyes of the wearer in both first and second masking layer. In above paragraphs, the reconstruction was based upon Baron reference in view of Pulji, the secondary reference, not the other way around.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that



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any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

The modification is proper, discussed above, where it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the openings for the eyes on the mask of Baron, providing an alternative solution to increase the visibility of the mask wearer.

First, Baron clearly suggest that the protective headgear requires to protect the wearer's head and face without impairing his vision (e.g., column 1, lines 60-65; "... *another object of the present invention to provide protective headgear for protecting the wearer's head and face without impairing his vision ... etc.*" & column 4, lines 50-55; "... *the interior shell below the wearer's eyes where it is clearly visible ... etc.*").

Second, secondary reference Pulji clearly teaches openings for the eyes on the mask, which would further enhance the wearer's vision.

Therefore, the modification is desirable as both prior art clearly suggests and teaches the openings for the eyes on the mask to further enhance the wearer's vision. In addition, the reconstruction of an eye openings are possible on Baron reference, because Baron has an aperture (e.g., 34) provided in the shell, first and second layers,

opposite the location of the wearer's mouth (e.g., column 3, lines 20-55) on a pair of transparent inflatable shock absorbing air chamber.

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacob Y. Choi whose telephone number is (571) 272-2367. The examiner can normally be reached on Monday-Friday (10:00-7:00).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on (571) 272-2378. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jacob Y Choi  
Examiner  
Art Unit 2875

JC



Sandra O'Shea  
Supervisory Patent Examiner  
Technology Center 2800